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JUN 17 2004

Matthew E. Mulkeen
FOLEY & LARDNER
Washington Harbour
3000 K. Street, N.W., Suite 500
Washington, D.C. 20007-5109

In re Application of
Jonathan Richard Anthony ROFFEY et al
Serial No.: 10/009,567
Filed: April 5, 2002
Attorney Docket No.: 040283-0196

DECISION ON PETITION

This is in response to applicant's "Petition Against Restriction Requirement" filed December 1, 2003. The delay is regretted.

On June 6, 2003, the examiner issued a restriction requirement, dividing the invention into six groups. See Office action dated June 6, 2003 for the Groups. The claims were indicated as lacking special technical feature as defined a contribution over the prior art. The examiner, specifically, alleged that the N-amino indoline did not define a contribution over 5,633,276. On July 7, 2003, applicants filed a response identifying with traverse that following group for examination: Formula (I), wherein R_1 - R_7 are as found in claim 1 and A is a 2,3-dihydrofuryl. Applicants requested that examination begin with Example 3 as the elected species. Applicants argued that the finding of the lack of unity was improper because it ignore the totality of the claimed structure, which was a N-amino indoline with a branched amino ethyl group, i.e. a - $(CH_2)(CHR_3)pNR_1R_2$. On September 29, 2003, an Office action was issued. While the examiner expand certain aspects of examination over the original restriction requirement. The examiner further stated that the aminoethyl group is not considered part of the invention. The examiner also stated that even the aminoethyl group were considered part of the invention, the invention would still not have a special technical feature over US'829. On December 1, 2003, the present petition was filed. Applicants urge that if Formula (I) viewed as a whole, it should be recognized that Formula (I) is a tricyclic indoline-type moiety with a branched 2-aminoalkyl group attached to the N of the tricyclic indoline and that is the shared common core. Applicants rely on PCT administrative Instruction, Annex B, Part I, specifically, Examples 19 and 20, for support. Applicants further urge that all of the method claims have unity of invention because they are linked by a common structure.

The Lack of Unity and applicants' arguments have been carefully reviewed and considered. The tricyclic indoline in Formula (I) contains a A ring, which is a 5- or 6- member ring optionally containing one or more heteroatoms wherein the atoms of the ring A, other than the unsaturated carbon atoms of the phenyl ring to which the ring A is fused, are saturated, or a pharmaceutically acceptable salt, addition compound or prodrug thereof. Thus the tricyclic indoline is **not a fixed structure** rather various tricyclic indoline structures. The various tricyclic ring systems, for examples, benz[g]indoliny, tetrahydrofuro[2,3,g]indoliny, tetrahydro-pyrano[2,3-g]indoliny, have diverse chemical structures and would not considered to be a common core. Thus there is **not a shared common** chemical structure. The restriction is deemed proper. Accordingly, the petition is denied.

Petition Denied.

Should there be any questions with regard to this letter please contact Cecilia Tsang by telephone at 571-272-0562 or by letter addressed to the Director, Technology Center 1600, P.O. Box 1450 Alexandria, VA 22313-1450.

A handwritten signature in black ink, appearing to read 'Bruce Kisliuk', with a stylized flourish at the end.

Bruce Kisliuk
Director, Technology Center 1600